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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,711	07/27/2001	Rathbun Rhodes	1146-8	8240
20995	7590	07/23/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/916,711	RHODES ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-15 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15 and 21-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant's election of species I, claims 1-10, 12-15, and 21-33 in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-10, 12-15, and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shults et al in view of Nagata et al. Shults et al shows a glucose sensing device including a housing made from polyethylene, (see column 9, lines 35-36), where the housing includes a sensing area having a working reference and counter electrode 20, 21, and 22, and a multi-layer membrane over the electrode area. The area of the counter and working electrodes appears to be the same. However, Nagata et al shows a 3 electrode system for measuring glucose concentration, where the counter electrode is made larger than the working electrode (see figures 9 and 10) to stabilize the potentials of the electrodes. Therefore, it would have been obvious to modify Shults et al to use such an arrangement of working and counter electrodes, so as to stabilize the potential of the electrodes. The examiner notes that Nagata does not disclose the relative sizes of the electrodes. However, by examining the cover figure, the working electrode has a diameter of 5 mm, and the counter electrode has an inner diameter of 14 and an outer diameter of 21 mm. Using these dimensions, the area of

the counter electrode is 5 (half circle) to 10 (full circle) times the area of the working electrode. The multi-layer membrane includes (from farther away to adjacent to electrodes) an angiogenic layer which is equivalent to the disclosed cell disruptive domain, a second layer which is the bioprotective layer, which is equivalent to the cell impermeable domain, then an enzyme membrane comprised of a resistance layer, an enzyme layer, an interference layer, and a electrolyte (i.e. hydrogel layer). The examiner notes that with respect to claim 6, the first domain is the angiogenic layer and the bioprotective layer. With respect to claim 7, the resistance layer is the second domain and excludes glucose. With respect to claims 8 and 9, the enzyme layer is the third domain. Both the working and counter electrodes are made from platinum (see column 9, line 62- column 10, line 2). The device of Shults is implanted. Shults further teaches the recited method.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shults et al in view of Nagata et al as applied to claims 1, 2, 5-10, 12-15, and 2-33 above, and further in view of Schulman et al 6119028. Shults does not teach a material for the resistance layer. However, Schulman shows a membrane 24 that behaves in the same manner of the resistance layer. Membrane 24 of Schulman is made from silicone, which is disclosed to be the material used for the oxygen antenna domain. Hence, it would have been obvious to modify Shults to make the resistance layer from silicone, as it is merely the substitution of one known material for another. Hence, membrane 24 is an oxygen antenna. With respect to claim 7, membrane 24 is a glucose exclusion membrane

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shults et al in view of Nagata et al as applied to claims 1,2, 5-10, 12-15, and 22-33 above, and further in view of Ward et al et al. Ward et al shows an analyte sensing device with a ceramic housing. Hence, it would have been obvious to modify Shults et al to use ceramic, as it is merely the substitution of one known equivalent material for another.

Applicant's arguments filed 4/26/2004 have been fully considered but they are not persuasive.

Applicant has asserted that there is motivation to modify a two electrode system, but not a three electrode system based on Nagata, as Nagata states in the background section that there is no stability problem in three electrode systems, requiring the counter electrode to be larger than the working electrode. However, in the first paragraph on page 2, Nagata teaches that in some circumstances, the same requirements (larger counter electrode) is necessary in a three electrode system. Therefore, it is the examiner's position that ample motivation exists to make the combination.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3736

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

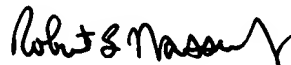
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RLN
July 19, 2004

Robert L. Nasser
Primary Examiner
Art Unit 3736



ROBERT L. NASSER
PRIMARY EXAMINER